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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/398,377    09/17/99    BITLER    S    12969

T H P RICHARDSON  
SHELDON & MAK  
225 SOUTH LAKE AVENUE  
SUITE 900  
PASADENA CA 91101

IM22/0420

EXAMINER

SZEKELY, P

ART UNIT

PAPER NUMBER

1714

DATE MAILED:

04/20/00

Please find below and/or attached an Office communication concerning this application proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

39 8377

Applicant(s)

Bitler

Examiner

Peter Sackels

Group Art Unit

1714

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 9/17/99
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-4 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-4 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 1714

1. The examiner, who has much less than ordinary skill in the art, respectfully asks applicant to supply him with a list of SCC polymers, <sup>and oils since</sup> ~~Since~~ he does not have the time, the energy or the inclination to chew himself through 11 patents and 15 articles to acquire the necessary knowledge and information.

2. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

3. The attempt to incorporate subject matter into this application by reference to the articles on page 6, lines 14-18 is improper because non-patent publications cannot be incorporated by reference. See MPEP 608.01(p).

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1714

5. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. In paragraph (I), the expression "e.g." renders the claims indefinite. The abbreviation means "for example".

7. Regarding claim 1, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

9. (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1714

11. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mondet et al. 5,519,063 or Kao Corp JP - 4 - 100534A.

12. Mondet et al. disclose a copolymer of an ester of a long chain alcohol and unsaturated sulfonic acid and a second copolymer which is a copolymer of an ester and an acrylamide or N-vinylpyrrolidone as thickeners for oil (claim 1). <sup>the</sup> sulfonic acid is not in the form of salts. Heat is used to accelerate the dissolution. Kao Corporation teaches a fluoropolymer having a perfluoroalkyl group and an alkyl group in its molecule and silicone oil. The method of dissolving the polymer is immaterial, unless it is shown that the resulting solution is superior to solutions made by different methods. Applicant's claims are not novel. In the alternative, it would have been obvious to one having ordinary skill in the art, at the time the invention was made to select applicant's polymer from a list of equivalents.

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13. Claims 1, 3 and 4 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Korbanka et al. 3,355,394, Hase et al. 4,057,622, Hase et al. 4,057,623 or Hase et al. 4,057,624.

14. Korbanka et al. recite oil, water and a copolymer of ethylene and N-vinyl-<sup>caprolactam</sup>~~caprolactam~~ or ~~on~~ N-methyl - N- vinyl- acetamide. See claims 1-10.

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The polymers are dissolved in hot liquid olive oil (column 2, lines 1-8). Hase et al. ('622) divulge and copolymer of <sup>N-vinylimidazole</sup>~~N-vinylimideazole~~ and acrylates, water and an oily phase. See claims 1-7. <sup>The</sup> polymers are dissolved at 60 - 70 C (column 3, lines 20-27). Hase et al. ('623)

P.S.  
4/19/00

Art Unit: 1714

reveal a similar system, but the other monomer with acrylates is N-vinylpyrrolidone. See claims 1-9 and column 3, lines 55-63. Hase et al. ('624) present a similar system, but the other monomer with acrylates is acrylamide. See claims 1-9 and column 4, lines 10-16. Applicant's claims are not novel. For rationale of anticipation and obviousness see paragraph #12.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekely whose telephone number is (703) 308-2460. The examiner can normally be reached on Tuesday - Friday from 7:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599 or 5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Peter Szekely/om  
April 19, 2000

**PETER A. SZEKELY  
PRIMARY EXAMINER  
GROUP 1500**